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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/635,598

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David Louis Kaminsky

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1386

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03/05/2008

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SUITE 3020

BOCA RATON, FL 33487

EXAMINER

TANG, KAREN C

ART UNIT

PAPER NUMBER

2151

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03/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/635,598	Applicant(s) KAMINSKY ET AL.	
	Examiner KAREN C. TANG	Art Unit 2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/6/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-24 are presented for examination.
2. Argument persuasive on Appeal Brief filed on 12/26/07, pages 8, Lines 4-9, therefore, the prosecution is now re-open.

DETAILED ACTION

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4 are rejected under 35 U.S.C. 101 because "intelligent electronic mail (e-mail) gateway" can be interpreted as software module (please see Specification Page 11, Paragraph 0023). Therefore, Claims 1-4 failed to be limited to embodiments which fall within a statutory category.

Specification

Claims 15-24 are objected to because according to MPEP 608.01, antecedent basis for the

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terms appearing in the claims, while an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. Applicant will be required to make appropriate amendment to the description to provide clear support or antecedent basis for the terms appearing in the claims provided no new matter is introduced.

Claims 15-24 which contains the terminology "The machine readable storage" are lacking clear support or antecedent basis in the description of the specification. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 5, 6, 9, 15, 16, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Tomkow et al hereinafter Tomkow (US 2006/0112165).

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3. Referring to Claims 1, 4, 5, and 15, Tomkow disclosed storing received e-mail messages prior to forwarding said messages to inboxes of respective mail servers (before sending the message to the destination, the messages is in the server/Rpost, refer to 0177 and 0080); detecting an impairment to delivering said messages to said inboxes (refer to 0129); identifying senders for selected one of said messages (refer to 0095-0097); and forwarding a notification of said impairment to said identified senders (refer to 0097).

4. Referring to Claims 6 and 16, Tomkow disclosed wherein said storing step comprises the step of queuing received e-mail messages prior to forwarding said messages to inboxes of respective mail servers (refer to 0177 and 0080).

5. Referring to Claims 9 and 19, Tomkow disclosed wherein said detecting step comprises the steps of: attempting to transmit said messages (refer to 0129); and, concluding the existence of an impaired state when said attempt fails (refer to 0129).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 12, 13, 14, 22, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomkow (US 2006/0112165) in view of Horvitz et al hereinafter Horvitz (US 2002/0087649).

6. Referring to Claims 2, 12, 13, 14, 22, 23, and 24, Tomkow disclosed wherein for each of said identified senders, formatting a notification comprising both a statement of said impairment (refer to 0147-0163) and forwarding said detailed notification to said identified senders (refer to 0147).

Although Tomkow disclosed the invention substantially as claimed, Tomkow is silent regarding “disclosed an alternate e-mail address for use in retransmitting a corresponding one of said messages”

Horvitz, in an analogous art disclosed an alternate e-mail address (refer to 0277) for use in retransmitting a corresponding one of said messages (refer to 0277);

Hence, providing an alternate email address for the sender to retransmit the email messages, would be desired for users to utilize due to the fact it provides the fastest time and proper knowledge of how to retransmit the messages to the proper destination.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Tomkow by including the features disclosed by Horvitz that efficiently improve the overall functionality of the system.

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Claims 7, 8, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomkow (US 2006/0112165) in view of Delaney et al hereinafter Delaney (US 2006/0177021).

7. Referring to Claims 7, 8, 17, and 18, Tomkow disclosed wherein said detecting step comprises the step of consulting a data store of state information that already have identified impairment (refer to 0033).

Although Tomkow disclosed the invention substantially as claimed, Tomkow is silence regarding “consulting a data store of state information for selected ones of said respective mail servers to call an already identified impairment.”

Delaney, in an analogous art disclosed consulting a data store of state information for selected ones of said respective mail servers to call an already identified impairment (server identified the known restriction or refer to 0058).

Hence, providing consulting a data store of state information for selected ones of said respective mail servers to call an already identified impairment disclosed by Delaney, would be desired for users to utilize due to the fact it can save loading time and efficiently eliminate unwanted mail from the mail system.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Tomkow by including the features disclosed by Delaney that efficiently improve the overall functionality of the system.

Claims 3, 10, 11, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomkow (US 2006/0112165) in view of Tomkow hereinafter Tomkow54 (US 20020144154).

8. Referring to Claims 3, 10, 11, 20 and 21, although Tomkow disclosed the invention substantially as claimed, Tomkow is silence regarding: wherein said step of identifying comprising the step of identifying only priority senders.

Tomkow54 in an analogous art disclosed, wherein said step of identifying comprising the step of identifying only priority senders (refer to Claim 7).

Hence, providing step of identifying only priority sender disclosed by Tomkow54, would be desired for users to utilize due to the fact it eliminate non priority senders and saving processing time.

Therefore, at the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the system of Tomkow by including the features disclosed by Tomkow54 that efficiently improve the overall functionality of the system.

Conclusion

9. **Examiner's Notes:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references

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in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

10. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen C. Tang whose telephone number is (571)272-3116. The examiner can normally be reached on M-F 7 - 3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Karen C Tang/

Examiner, Art Unit 2151

/John Follansbee/

Supervisory Patent Examiner, Art Unit 2151